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Not such a beautiful game: *Tartan Army Limited v Alba Football Fans*

In *Tartan Army Limited v Alba Football Fans Limited*,¹ the Court of Session has issued a rare decision on trade mark validity and infringement. Difficulties in the Court's approach have, however, led to a surprising and ultimately unsatisfactory result.

A. THE FACTS

First used in the 1970s, the "Tartan Army" is the name informally given to the body of Scotland football fans.

In the late 1990s, Ian Aidie – a committed Scotland football fan, but not purporting to act as a representative of the "Tartan Army" – had the idea of developing the "Tartan Army" name into a brand. Through a company which he controlled, Mr Aidie registered various trade marks in the UK and elsewhere for the marks "THE TARTAN ARMY" and "TARTAN ARMY" in relation to goods such as clothing, headgear, scarves and flags.²

In 2005, two individuals, John Tannock and Iain Emerson, approached Mr Aidie about a magazine, entitled "The Famous Tartan Army Magazine", which they wished to launch. Mr Aidie made no objection to this.³

In 2006, the "TARTAN ARMY" trade marks were assigned to the pursuer, a company controlled by Mr Aidie and his brother. The pursuer also filed an EU trade mark for "THE TARTAN ARMY", covering goods such those noted above and various services including retail, travel, publishing and catering services. Mr Aidie and his brother thereafter sold their interest in the pursuer.⁴ Although the fortunes of the Scottish football team fluctuated, the pursuer's new owners continued to use the "TARTAN ARMY" marks on merchandise and for other activities, including organisation of supporters' trips to Scotland away games.⁵

¹ *Tartan Army Limited v Sett GmbH, Oliver Reifler, Iain Emerson, Alba Football Fans Limited* [2017] CSOH 22 (unreported).

² *Tartan Army* at paras 7-8 and 12-16.

³ *Tartan Army* at paras 17-20.

⁴ *Tartan Army* at paras 7 and 21. "EU trade mark" is the new name for "Community trade marks", a form of registered trade mark having unitary effect across the EU: see Community Trade Mark Regulation 2015/2424.

⁵ *Tartan Army* at paras 22-32.

The present dispute arose in around 2007. It was discovered that the producers of “The Famous Tartan Army Magazine” had organised a supporters’ trip to Paris. The pursuer’s new owners objected. In 2008, a further supporters’ trip to Amsterdam was organised. In response, the pursuer withdrew any previously-granted permissions to use the “TARTAN ARMY” mark.⁶

Undertakings were sought from Mr Emerson and others but were not forthcoming and proceedings were commenced in 2009. The litigation was initially slow. By the time of proof,⁷ the case against the first, second and third defenders had fallen away.⁸ The pursuer claimed passing off and infringement by the fourth defender, Alba Football Fans Limited (“Alba”), of the pursuer’s UK and EU trade marks in relation to the publication of ‘The Famous Tartan Army Magazine’ and the provision of travel services. The action came before Lord Glennie sitting as an IP judge. Alba denied infringement and counterclaimed with an extensive attack on the validity of the pursuer’s UK and EU trade mark registrations.

B. THE DECISION

(1) Validity

As a result of a successful non-use revocation attack by Alba (not discussed further here) and the dropping of various goods and services from the pursuer’s EU trade mark in the time period before proof, the pursuer was left with only quite narrow registered trade mark rights, covering clothing and headgear in class 25 (the UK and EU trade marks), beers in class 32 (the EU trade mark) and online publishing in class 41 (the EU trade mark).⁹

In order to be validly registered, a mark must not fall within any of the so-called “absolute grounds” for refusal or invalidation of a trade mark to be found at section 3 Trade Marks Act 1994 (“TMA”) and Article 7 Community Trade Mark Regulation (“CTMR”). The TMA and CTMR are, for present purposes, identical. By section 3(1)(a) TMA, a “sign” (the trade mark law terminology for a putative trade mark) must fall within the definition of what may constitute a registered trade mark set out at section 1(1) TMA, being signs capable of being represented graphically which are also “capable of distinguishing” goods or services of one

⁶ *Tartan Army* at paras 34-39.

⁷ For which various procedural innovations were implemented: B Heaney, ‘Innovative measures taken to shorten proof – *Tartan Army Ltd v Sett GmbH*, 2017 CSOH 22, Lord Glennie, 10 February 2017’ Civ. P.B. 2017, 134, 7-8.

⁸ Settled against the first and second defenders; dismissed against the third defender: *Tartan Army Limited v Sett GmbH, Oliver Reifler, Iain Emerson, Alba Football Fans Limited* [2015] CSOH 141 (unreported).

⁹ *Tartan Army* at paras 8, 127-128 and 159-167.

undertaking from those of other undertakings. This is, however, rarely invoked as a ground of objection in practice. The three most commonly-invoked “absolute” objections are that a trade mark:

- is devoid of any distinctive character;¹⁰
- consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;¹¹ or
- consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.¹²

Alba challenged the pursuer’s trade mark registrations under all of sections 3(1)(a)-(d) TMA. They argued that the pursuer’s marks could not be distinctive because, at the time that they were filed, the name “Tartan Army” was well-known as a description of the body of travelling supporters of the Scotland football team.

The Court agreed that the “Tartan Army” name:

“is and has for a long time been used as a collective noun for the
“disorganisation” of Scottish football fans indulging their passion to support the
Scottish football team on the international stage”.¹³

However, perhaps somewhat surprisingly given this finding, Alba’s validity challenge was rejected. According to the Court, the generic meaning of the “Tartan Army” name was not incompatible with the pursuer’s marks possessing the necessary distinctiveness. On the evidence, until the pursuer’s trade marks were registered no-one had sought to use the expression “Tartan Army” on any goods or services; it was simply “an amorphous, well understood but ill-defined term to indicate the mass of Scottish football supporters”.¹⁴ The fact that the mark was used as a badge of allegiance to the Scotland football team did not prevent it being registered.¹⁵ There was no element in the “TARTAN ARMY” marks which was descriptive of a characteristic or quality

¹⁰ Section 3(1)(b) TMA.

¹¹ Section 3(1)(c) TMA.

¹² Section 3(1)(d) TMA.

¹³ *Tartan Army* at para 152.

¹⁴ *Tartan Army* at para 153.

¹⁵ *Tartan Army* at para 156.

of the goods or services for which the marks were registered – there being, for example, nothing so rigidly uniformed about what Scotland football supporters wear that there could be said to be any “typical Tartan Army clothing” - nor had the words “TARTAN ARMY” become customary in relation to the claimed goods and services.¹⁶

(2) Trade mark infringement

Alba raised defences in personal bar and acquiescence which were rejected for reasons not examined here.¹⁷ The focus here is the Court’s findings on the underlying claims in trade mark infringement.

Registered trade mark infringement is governed by sections 10(1)-(3) TMA and identical provisions at Article 9 CTMR. The Court rejected the pursuer’s argument that “The Famous Tartan Army Magazine” should be regarded as identical to the pursuer’s “TARTAN ARMY” marks for the purposes of infringement under section 10(1) TMA. In the Court’s view, the presence of the word “Famous” in the magazine title was a “not unimportant” point of distinction, indicating that the magazine was for, or owed its allegiance to, the “famous Tartan Army” in the generic sense of Scotland football fans.¹⁸ This ground of infringement failed.

Turning to section 10(2) TMA, the Court accepted that the name of the magazine was similar to the pursuer’s “TARTAN ARMY” marks and was being used in relation to identical or similar goods or services. There is, however, also a requirement to demonstrate a “likelihood of confusion” on the part of the public for this ground of infringement to succeed. Again perhaps surprisingly given the Court’s earlier conclusions on distinctiveness, the Court held that there was no such likelihood of confusion. The Court noted again:

“... the wording of the magazine title is such as direct attention to the famous Tartan Army, the “disorganisation” of Scotland football fans, and to hold the Magazine out as a magazine belonging to the fans. It does not point naturally to an association with the pursuer”.¹⁹

¹⁶ *Tartan Army* at para 157.

¹⁷ *Tartan Army* at paras 131-148.

¹⁸ *Tartan Army* at para 170.

¹⁹ *Tartan Army* at para 171.

The infringement claim under section 10(3) TMA CTMR also failed. The pursuer needed to prove that its trade marks had a “reputation” and that Alba’s actions took unfair advantage of or were detrimental to the distinctive character or repute of its marks. In the Court’s view, the evidence did not indicate that the pursuer’s trade marks were widely known among Scotland football supporters; even if so known, for the reasons noted above, the presence of the word “Famous” in the magazine title was sufficient to prevent any association with the pursuer’s marks and to mean that there was no infringing “free-riding”.²⁰ The Court dismissed the infringement claim in relation to Alba’s provision of travel services for the same reasons.²¹

C. COMMENT

Readers could be forgiven for finding the Court’s conclusions on validity and infringement intuitively difficult to reconcile. On the one hand, while accepting that the “Tartan Army” name had a long-standing generic meaning, the Court nonetheless upheld the pursuer’s trade marks as distinctive. On the other hand, while upholding the pursuer’s trade marks, the Court held that there was no infringement by the defenders – because of the well-established generic meaning of the “Tartan Army” name.

It is respectfully suggested that the Court fell into a number of errors in its approach to both trade mark validity and infringement. The better view must surely be that, if valid, the pursuer’s trade mark registrations were infringed but that, as a matter of fact and law, the pursuer’s trade marks were not valid such that no infringement could arise.

On infringement, the Court attached great significance to the presence of the word “Famous” in the title of Alba’s magazine as negating any possibility of association or confusion. Such a generic, laudatory term would, however, not normally be taken as distinguishing the goods or services of different undertakings in this way.²² One would anticipate that such an unexpected finding by the Court would be supported by evidence of the very particular meaning

²⁰ *Tartan Army* at para 172.

²¹ The claims in passing off were also dismissed: *Tartan Army* at paras 173 and 175.

²² On laudatory terms generally, see: Trade Marks Manual, UK IPO (2016) (available at https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/587937/Manual-of-trade-marks-practice.pdf); and Guidelines for Examination of European Union Trade Marks - Part B, Section 4, Chapter 3 - Non-Distinctive Trade Marks, EU IPO (2017) (available at <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>).

said to be attached to the word “Famous” by members of the public in this particular case. There is, however, no reference to such evidence in the Court’s decision.

On validity, the Court took “the crucial question” to be whether the “TARTAN ARMY” marks were “capable of distinguishing” the goods and services of one undertaking,²³ using the language of the definition of a registrable trade mark at section 1(1) TMA. Consistent with Court of Justice case law, however, the better view is that this is not the source of the requirement of trade mark distinctiveness, which is instead determined through application of sections 3(1)(b)-(d) TMA.²⁴ The CJEU has repeatedly stressed that each of sections 3(1)(b)-(d) TMA is independent and must be separately examined in the light of its own underlying public interest.²⁵

A mark is only registrable under section 3(1)(b) TMA if it “may be *perceived immediately* as an indication of the commercial origin of the goods or services in question so as to enable the relevant public to distinguish *without any possibility of confusion* the goods or services of the owner of the mark from those of a different commercial origin” (emphasis added).²⁶ It is important to recall that the pursuer was not acting in any form of representative capacity for the “Tartan Army” as a body of fans, nor was the pursuer connected to the Scottish football team. Curiously given its ultimate decision, the Court did accept that “many” of the witnesses “would not have said that clothing and other merchandise marked with the words Tartan Army originated from the pursuer or any other particular entity”.²⁷ As a summary of the evidence, this is something of an understatement: across the fifteen witnesses unconnected with the parties who gave evidence, all but two attested that they understood “TARTAN ARMY” only as a generic reference to the “Tartan Army” fans; the two witnesses who did recognise some trade mark significance had both already become aware of the pursuer’s trade mark activities.²⁸

Sections 3(1)(c) and (d) TMA are underpinned by a public interest in ensuring that signs which consist of generic terms or descriptive expressions which other traders may have a legitimate interest in using cannot be monopolised through trade mark registration but instead

²³ *Tartan Army* at para 150; see also paras 151, 153 and 154.

²⁴ C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475 at para 40 and 46 (“Articles 2 and 3(1)(a) of the Directive do not constitute a separate ground for refusing registration of a sign in connection with a lack of distinctiveness”).

²⁵ For example: *Philips* at para 77; C-456/01 P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2004] ECR I-5089 at para 45.

²⁶ *Go Outdoors Ltd v Skechers USA Inc II* [2015] EWHC 1405 (Ch) at para 11(v), summarising CJEU authority.

²⁷ *Tartan Army* at para 153; see also para 154.

²⁸ See the summary of the witness evidence at *Tartan Army* paras 48-63.

remain freely available for use by all.²⁹ Concerns expressed by witnesses that the pursuer had sought wrongfully to appropriate a term already in wide descriptive usage were given short shrift,³⁰ but the significance in trade mark law of such concerns appears to have been overlooked. Terms identifying the subject matter of goods or services or identifying target consumers can be descriptive of “characteristics” so as to fall foul of section 3(1)(c).³¹ Well-known names may also be considered descriptive of the subject matter of goods or services if understood by the public as generic.³² In *Linkin Park LLC’s Application*, for example, an application to register “LINKIN PARK” in relation to printed matter, posters and books was rejected on the basis that the mark had a well-established meaning denoting the rock band of that name and thereby denoted the subject matter of the goods.³³ In *Score Draw Ltd v Finch*, an application to register the former badge of the Brazilian national football team for clothing was rejected because its association with the historic Brazilian “[robbed] the badge of its power to be distinctive of trade origin”.³⁴ In *Rugby Football Union and Nike European Operations Netherlands BV v Cotton Traders Ltd*, a Community trade mark registration for an historic version of the English rugby team’s rose emblem was invalidated on the grounds that the rose was taken primarily by consumers as denoting association with the England rugby team rather than trade origin and served an indicator of the character of clothing as something to be worn as an expression of loyalty to the team.³⁵ On the facts in this case, the Court did accept that there was some evidence of use of the “Tartan Army” name by third parties simply to describe the subject matter of goods rather than trade origin.³⁶ The Court also accepted that there was evidence of use of the “Tartan Army” name in the press,³⁷ although (oddly, given the importance of publishing services to the

²⁹ D Keeling et al, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th ed, 2014), paras 8-089 and 8-111. See for example also: C-108/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber* [1999] ECR I-2779 at para 25; Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc., Rado Uhren AG* [2003] ECR I-3161 at para 73; C-191/01 P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* [2003] ECR I-12447 at para 31.

³⁰ *Tartan Army* at para 153.

³¹ Guidelines for Examination of European Union Trade Marks - Part B, Section 4, Chapter 4 - Descriptive Trade Marks, EU IPO (2017) at para 1.3 (available at <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>).

³² *Ibid*, para 2.7.

³³ [2006] ETMR 74, carefully distinguishing and confining to its own facts the *Arsenal* decision which appears to have influenced the Court in the present case.

³⁴ [2007] ETMR 54 at para 32. Mann J also distinguished the *Arsenal* decision.

³⁵ [2002] ETMR 76.

³⁶ *Tartan Army* at para 155.

³⁷ *Tartan Army* at para 155.

infringement side of the case) without going on specifically to analyse the implications of this in relation to the claimed distinctiveness of the pursuer's marks for online publishing in class 41.

Given the ongoing existence and activities of the "Tartan Army", the validity of the pursuer's trade marks is a matter of continuing public interest. The Court's remarks on supporters groups throw the issues into particularly sharp relief. Surprisingly, the Court appears to have viewed use of the "Tartan Army" name by such groups on banners and the like as *prima facie* infringement of the pursuer's marks, to be saved only because the pursuer was "willing to accommodate" it or because there might be a defence that such use was "simply descriptive" of "participation in the larger mass of Scottish fans".³⁸ The possibility that such activity might, in the face of the long history of the "Tartan Army" name, now constitute *prima facie* trade mark infringement serves only to highlight all the more acutely the case for invalidation of the marks disputed in this action.

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³⁸ *Tartan Army* at para 155.